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EXAMINER

BROWN, TIMOTHY M

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3625

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/849,979

Applicant(s)

GANESAN ET AL.

Examiner

Tim Brown

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 58-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 58-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. This Non-Final Office Action is responsive to Applicants' Amendment submitted November 25, 2002.

#### ***Drawings***

2. Applicants' Amendment has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

#### ***Specification***

3. The substitute specification filed on November 25, 2002 fails to conform to 37 CFR 1.125(b) because (1) it fails to include a marked up copy of the original specification, and (2) it includes claims 1-57.
4. If applicant desires priority under 35 U.S.C. 120 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed on or after November 29, 2000, any claim for priority must be made during the pendency of the application and

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within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2) and (a)(5). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) a surcharge under 37 CFR 1.17(t), and (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition should be directed to the Office of Petitions, Box DAC, Assistant Commissioner for Patents, Washington, DC 20231.

### ***Response to Arguments***

#### **Claim 58**

5. Applicants argue Van Dusen fails to teach or suggest "processing of the received request to generate a notification of the monetary gift for transmission to the designated recipient." (Amendment, p. 13). Van Dusen discloses a system for distributing electronic gift certificates. According to Van Dusen, a user orders a gift certificate for delivery to a recipient through an interactive Web page (col. 3, lines 37-47). The system accomplishes delivery of gift certificates through e-mail documents that include

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hyperlinks for automating the redemption process (col. 2, lines 55-67). Consequently, Van Dusen discloses processing of the received request to generate a notification of the monetary gift for transmission to the designated recipient.

6. Applicants further argue there is no motivation to combine the teachings of Van Dusen and Lenhart. In particular, Applicants point out the rejection of claim 58 is based on improper hindsight reasoning (Amendment, p. 15). However, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

7. Applicants further argue the references themselves fail to suggest the combination of Van Dusen and Lenhart. The Examiner respectfully disagrees. Van Dusen teaches a system for delivering electronic gift certificates by e-mail. Lenhart teaches a system for creating and delivering electronic greeting cards. In the art of giving gifts, it is customary to provide a card in association with a gift. In fact, the donor and recipient of a gift exchange are typically identified by a greeting card. Thus, by disclosing a system for delivering electronic gift certificates, Van Dusen suggests combining its teachings with the delivery of a greeting card as taught by Lenhart. Such a combination would provide a friendly and amusing environment for the notification of a gift.

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Claim 64

8. Applicants' arguments in connection with claim 64 are moot in view of the new grounds of rejection.

Claims 66 and 67

9. Applicants' amendment of claim 66 has necessitated a new ground of rejection. Consequently, Applicants' arguments in connection with claim 66 are moot.

Claim 68

10. Applicants suggest the combination of Van Dusen and Lenhart fails to teach transmitting the generated electronic greeting card to an electronic greeting card service prior to transmitting the electronic greeting card to the recipient (Amendment, p. 17). Lenhart discloses an electronic greeting card service wherein a user is permitted to send a customized electronic greeting to a recipient by e-mail (pp. 1 and 3). Sending the customized greeting involves the user downloading a selected greeting card, customizing the selected greeting card, and transmitting the customized greeting card to a greeting card vendor for delivery to the recipient. Naturally, the customized greeting card is transmitted to the greeting card vendor before it is forwarded to the recipient. Thus, Van Dusen's teaches transmitting the generated electronic greeting card to an electronic greeting card service prior to transmitting the electronic greeting card to the recipient.

Claim 59

11. Applicants arguments in connection with claim 59 are moot in view of the new grounds of rejection.

Claim 63

12. Applicants argue WishClick fails to disclose transmitting a greeting card to a designated recipient so that it may be further transmitted to a non-designated recipient so that the non-designated recipient can have the monetary gift credited to his or her account. WishClick discloses a personal gift registry wherein existing members earn a monetary sum for encouraging non-members to register with the personal gift registry (p. 1). Similarly, newly-registered, who were previously non-members, are given the opportunity to earn a monetary sum by registering other new members. Thus, WishClick discloses conferring a monetary gift to an individual that was not previously a member of the service. Like a non-member, a non-designated recipient is a donee for which a gift was not originally intended. Therefore, WishClick, in combination with Van Dusen and Lehart, discloses the limitations of claim 63.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**14. Claims 58-61 and 69-72 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Dusen (US 6,175,823).**

Regarding claim 58, Van Dusen teaches a method for making a monetary gift, comprising:

receiving, via a network, a request to send an electronic greeting card and to make an associated monetary gift in an amount, on behalf of a requesting donor to a designated recipient;

processing the received request to generate the electronic greeting card including a notification of the monetary gift;

transmitting, via the network, the generated electronic greeting card to the designated recipient; and

directing a crediting of funds equal to the monetary gift amount to a deposit account (see Abstract; col. 2, lines 58-64; col. 3, lines 37-67; col. 4, lines 33-54; and col. 5, lines 1-10).

Regarding claim 59, Van Dusen teaches the method of claim 58, wherein the electronic greeting card is transmitted to the designated recipient at one of 1) a time subsequent to the directing of the crediting of the funds to the deposit account, and 2) a time concurrent with the directing of the crediting of the funds to the deposit account (Id.).



Regarding claim 60, Van Dusen teaches the method of claim 58, wherein: the electronic greeting card includes a hyper-link; the funds are directed to be credited to the deposit account subsequent to an activation of the hyper-link; and the deposit account is at a financial institution (Id.).

Regarding claim 61, Van Dusen teaches the method of claim 60, further comprising: activating the hyper-link; and receiving, via the activated hyper-link, information identifying the designated recipient; wherein the funds are directed to be credited to the deposit account subsequent to receipt of the information identifying the recipient; wherein the deposit account is associated with the designated recipient (Id.).

Claims 69-72 are rejected under Van Dusen as discussed under claim 58-61 as these claims are directed to a system for accomplishing the method of claims 58-61.

***Claim Rejections - 35 USC § 103***

15. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**16. Claims 58, 66-69, 71-73, 75 and 77-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Dusen (US 6,175,823) in view of Lenhart (Lenhart, J. "Happy Holidays,' High-Tech Style; Sending Cards Over the Internet Gains Popularity," The Washington Post (December 20, 1998)).**

Regarding claim 58, Van Dusen teaches a method for making a monetary gift, comprising:

receiving via a network, a request to make a monetary gift in an amount on behalf of a donor, to a recipient (col. 3, lines 38-63);

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processing a notification of the monetary gift (col. 2, lines 55-67); and directing a crediting of funds equal to the monetary gift amount to a deposit account associated with the recipient (col. 2, lines 55-67; and col. 3, lines 6-14).

Assuming *arguendo* Van Dusen does not specifically teach the steps of receiving via a network, a request to send an electronic greeting card, processing the received request to generate the electronic greeting card and transmitting, via the network, the generated electronic greeting card to the designated recipient, Lenhart overcomes this deficiency. Lenhart teaches a Website operative to transmit an electronic greeting card wherein a sender fills out a personalized message (page 1, paragraphs 2 and 3; and page 3, paragraph 4). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Van Dusen to include the teachings of Lenhart because including the steps of receiving via a network, an input associated with an electronic greeting card, processing the donor's request and input to generate the electronic greeting card and transmitting, via the network, the electronic greeting card to the recipient would enable the donor to provide the recipient with a personalized greeting card along with the monetary gift.

Regarding claim 66, Van Dusen and Lenhart teach all the limitations discussed under claim 58. Assuming *arguendo* Van Dusen does not expressly teach a method for making a monetary gift, wherein the request is received from an electronic greeting card service, Lenhart overcomes this deficiency as discussed under claim 58.

Regarding claim 67, Van Dusen and Lenhart teach all the limitations discussed under claim 58 above. Van Dusen further teaches the crediting of funds being directed

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by a payment service provider. Assuming *arguendo* Van Dusen does not expressly teach a method of making a monetary gift wherein the request is received by, the received request is processed by and the generated electronic greeting card is transmitted by an electronic greeting card service, Lenhart overcomes this deficiency as discussed under claim 58.

Regarding claim 68, assuming *arguendo* Van Dusen does not specifically teach transmitting, via the network, the generated electronic greeting card to an electronic greeting card service prior to transmitting the electronic greeting card to the recipient, Lenhart overcomes this deficiency. Lenhart teaches a Website operative to transmit an electronic greeting card to a recipient wherein a user submits greeting card input, including a greeting card selection and a personalized message, to a Website server and wherein the Website server subsequently transmits the electronic greeting card to the user (page 1, paragraphs 2 and 3; and page 2, paragraph 4). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Van Dusen to include the teachings of Lenhart because transmitting, via the network, the electronic greeting card to an electronic greeting card service prior to transmitting the electronic greeting card to the recipient would enable the Van Dusen method to merge the request to make a monetary gift with a personalized electronic greeting card.

Claim 69 is rejected as discussed under claim 58 above as claim 69 pertains to a system for accomplishing the method of claim 58.

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Claim 71 is rejected as discussed under claim 60 above as claim 71 pertains to a system for accomplishing the method of claim 60.

Claim 72 is rejected as discussed under claim 61 above as claim 72 pertains to a system for accomplishing the method of claim 61.

Claim 73 is rejected as discussed under claim 62 above as claim 73 pertains to a system for accomplishing the method of claim 62.

Claim 75 is rejected as discussed under claim 64 above as claim 75 pertains to a system for accomplishing the method of claim 64.

Claim 77 is rejected as discussed under claim 66 above as claim 77 pertains to a system for accomplishing the method of claim 66.

Claim 78 is rejected as discussed under claim 67 above as claim 78 pertains to a system for accomplishing the method of claim 67.

Claim 79 is rejected as discussed under claim 69 above as claim 79 pertains to a system for accomplishing the method of claim 69.

Claim 80 is rejected as discussed under claim 58 above as claim 80 pertains to an article of manufacture for accomplishing the method of claim 58.

17. **Claims 59-62, 64 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Dusen (US 6,175,823) in view of Lenhart (Lenhart, J. "Happy Holidays,' High-Tech Style; Sending Cards Over the Internet Gains Popularity," The Washington Post (December 20, 1998)) and Hansell (Hansell, S. "Electronic Checks to Pay Bills Over the Computer," The New York Times (August 27, 1995)).**

Regarding claim 59, Lenhart and Van Dusen teach all the limitations discussed under claim 58 above. The combination of Van Dusen and Lenhart does not specifically teach a method for making a monetary gift wherein the electronic greeting card is transmitted to the recipient at one of (1) a time subsequent to the crediting of the funds to the deposit account associated with the recipient, and (2) a time concurrent with the crediting of the funds to the deposit account associated with the recipient. However, Hansell teaches transmitting an electronic check by e-mail as a birthday gift wherein the funds are immediately transferred to the recipient's bank account (p. 1).

At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Van Dusen and Lenhart to include the teachings of Hansell because adding a step wherein the electronic greeting card is transmitted to the recipient at one of (1) a time subsequent to the crediting of the funds to the deposit account associated with the recipient, and (2) a time concurrent with the crediting of the funds to the deposit account associated with the recipient would ensure that there were sufficient funds to pay for the monetary gift.

Regarding claim 60, Van Dusen and Lenhart teach all the limitations discussed under claim 58. Van Dusen further teaches a method for making a monetary gift wherein the notification includes a hyper-link (col. 2, lines 55-67; and col. 3, lines 6-14); and the funds are directed to be credited to the deposit account subsequent to an activation of the hyperlink (Id.). Assuming Van Dusen does not expressly teach an electronic greeting card that includes a hyperlink, Lenhart overcomes this deficiency as discussed under claim 58.

The combination of Van Dusen and Lenhart does not expressly teach a method of making a monetary gift wherein the deposit account is at a financial institution. However, Hansell teaches receiving an electronic check as a birthday gift wherein the check is automatically deposited in the account of the recipient (p. 1). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to combine the teachings of Van Dusen, Lenhart and Hansell. This combination would provide a means for a donor to automatically credit the money account the designated recipient. Accordingly, the recipient would not be limited to spending the gift amount at a designated merchant as disclosed in Van Dusen.

Regarding claim 61, Van Dusen further teaches activating the hyperlink (col. 2, lines 55-67; and col. 3, lines 6-14); and receiving, via the activated hyperlink, information identifying the recipient (Id.); wherein the funds are directed to be credited to the deposit account subsequent to receipt of the information identifying the recipient; wherein the deposit account is associated with the designated recipient (Id.).

Regarding claim 62, Van Dusen further teaches processing the received information identifying the designated recipient to determine if the designated recipient is a member of an enclosed community prior to directing of the crediting of the funds to the deposit account associated with the designated recipient (col. 3, lines 64-67; col. 4, lines 64-67; and col. 5, lines 1-10); and if it is determined that the designated recipient is not a member of the enclosed community, transmitting a notice, via the network, to the designated recipient, that the designated recipient must become a member of the

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enclosed community before the funds are directed to be credited to the deposit account associated with the designated recipient (col. 4, lines 64-67; and col. 5, lines 1-10).

Regarding claim 64, Van Dusen further teaches debiting a payment account associated with the requesting donor (col. 3, lines 55-63); wherein the payment account associated with the requesting donor is debited at one of (1) a time prior to transmitting the electronic greeting card to the recipient, and (2) a time subsequent to an activation of a hyper-link included in the transmitted electronic greeting card (Id.). The combination of Van Dusen and Lenhart does not expressly teach debiting a payment account at a financial institution. However, Hansell teaches using an electronic check to provide a donee with a monetary gift. Therefore, at the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to combine the teachings of Van Dusen, Lenhart and Hansell. By debiting a payment account at a financial institution, the donor is provided with another form of payment for making a monetary gift.

Claim 70 is rejected under Van Dusen, Lenhart and Hansell as discussed under claim 59 as claim 70 pertains to a system for accomplishing the method of claim 59.

**18. Claims 63 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Dusen (US 6,175,823) in view of Lenhart (Lenhart, J. "Happy Holidays,' High-Tech Style; Sending Cards Over the Internet Gains Popularity," The Washington Post (December 20, 1998)) and further in view of an article published in Business Wire ("WishClick Kicks Off Marketing Campaign by Tempting Consumers With Tell-a-Friend Promotion; Register with WishClick and receive up**

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**to \$50 in SuperCertificates from GiftCertificates.com,” Business Wire (November 2, 1999)) (hereinafter “WishClick”).**

Regarding claim 63, Van Dusen teaches all the limitations discussed under claim 58 above. Van Dusen does not specifically teach a method for making a monetary gift wherein the recipient is a first recipient and the notification includes a hyper-link, further comprising: further transmitting, via the network, the transmitted electronic greeting card to a second recipient; activating the hyper-link in the further transmitted electronic greeting card; receiving, via the activated hyper-link, information identifying a second recipient; processing the information identifying the second recipient to determine if the second recipient is a member of an enclosed community; if it is determined that the second recipient is not a member of the enclosed community, transmitting a notice, via the network, to the second recipient, that the second recipient must become a member of the enclosed community before funds are to be credited to a deposit account associated with the second recipient; and if it is determined that the second recipient is a member of the enclosed community, crediting funds equal to the monetary gift amount to a deposit account associated with the second recipient. However, WishClick teaches a Website operative to provide a personal gift registry wherein members of the Website are provided with a gift certificate for referring and successfully registering five new members (page 1, paragraphs 1-3). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Van Dusen to include the teachings of WishClick. By including the steps wherein the recipient is a first recipient and the notification includes a hyper-link, further comprising: further transmitting, via the



network, the transmitted electronic greeting card to a second recipient; activating the hyper-link in the further transmitted electronic greeting card; receiving, via the activated hyper-link, information identifying a second recipient; processing the information identifying the second recipient to determine if the second recipient is a member of an enclosed community; if it is determined that the second recipient is not a member of the enclosed community, transmitting a notice, via the network, to the second recipient, that the second recipient must become a member of the enclosed community before funds are to be credited to a deposit account associated with the second recipient; and if it is determined that the second recipient is a member of the enclosed community, crediting funds equal to the monetary gift amount to a deposit account associated with the second recipient, the Van Dusen method would be further operative to enable the first recipient to forward (re-gift) the monetary gift to a second recipient in the event that the first recipient is not interested in receiving the monetary gift or does not have a membership in the enclosed community.

Claim 74 is rejected as discussed under claim 63 above as claim 74 pertains to a system for accomplishing the method of claim 63.

**19. Claims 65 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Dusen (US 6,175,823) in view of Lenhart (Lenhart, J. "Happy Holidays,' High-Tech Style; Sending Cards Over the Internet Gains Popularity," The Washington Post (December 20, 1998)) and further in view Solokl et al. (US 6,173,269).**

Regarding claim 65, Van Dusen teaches all the limitations discussed under claim 58 above. Van Dusen does not specifically teach processing the received request to determine if the designated recipient is a member of an enclosed community prior to processing the request to generate the electronic greeting card including the notification of the monetary gift; wherein, if it is determined that the designated recipient is not a member of the enclosed community, the transmitted electronic greeting card includes a notification that the recipient must become a member of the enclosed community before the funds are directed to be credited to the deposit account. However, Solokl et al. teach a virtual automatic teller machine wherein a vendor may withdraw funds from an account associated with a user and wherein a donor may make a monetary gift to the user account (col. 8, lines 34-54). Solokl et al. further teach determining whether a user account is associated with an intended recipient of a monetary gift and if no user account is detected, permitting the user to establish a gift account for the intended recipient (Id.). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Van Dusen to include the teachings of Solokl et al. because including the step of processing the request to determine if the recipient is a member of an enclosed community prior to processing the request and the input to generate the electronic greeting card including a notification of the monetary gift; wherein, if it is determined that the recipient is not a member of the enclosed community, the notification includes a notification that the recipient must become a member of the enclosed community before funds will be credited to the deposit account associated with the recipient. Modifying Van Dusen in this manner would encourage

the recipient to establish an account such that the donor's monetary gift would have a destination.

Claim 76 is rejected as discussed under claim 65 above as claim 76 pertains to a system for accomplishing the method of claim 65.

**Conclusion**

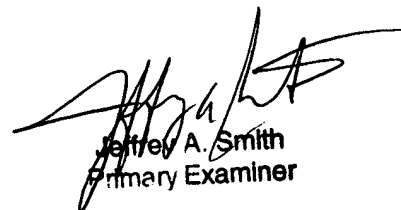
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (703) 305-1912. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Tim Brown  
Examiner  
Art Unit 3625

TB  
February 24, 2003

  
Jeffrey A. Smith  
Primary Examiner

## **Recent Statutory Changes to 35 U.S.C. § 102(e)**

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.